

## REMARKS

The Examiner's objection Under 37 C.F.R. §1.172(a) is respectfully traversed.

In support of this traverse, applicant submits that Medtronic, Inc. had purchased U.S. Patent No. 5,773,313 in April 1998n from Exonix Corporation d/b/a Exonix Biomedical Engineering, but for some reason, an assignment had not been executed and recorded at that time. To rectify this situation, an assignment has now been prepared and executed and enclosed is a copy of an assignment from Exonix Corporation, d/b/a Exonix Biomedical Engineering, of Miami, Florida to Medtronic, Inc. of Minneapolis, Minnesota. This assignment is now being recorded at the United States Patent and Trademark Office.

As per the Examiner's request, a statement under 37 C.F.R. § 3.73(b), signed by an Officer of the Assignee Medtronic, Inc. regarding the chain of title from the inventors to Exonix Corporation d/b/a Exonix Biomedical Engineering, and from Exonix Corporation, d/b/a Exonix Biomedical Engineering, to Medtronic, Inc. is attached together with a copy of each assignment, a copy of the Notice of Recordation of the first assignment setting forth the reel and frame nos., and a current Power of Attorney to the undersigned attorney..

In response to the Examiner's rejection of claim 29 Under 35 U.S.C. §251 for being an improper recapture of broadened claim subject matter surrendered in the application for the patent upon which the present reissue is based, applicant respectfully traverses this rejection as it may be attempted to be applied to amended claim 29.

The language the Examiner contends was added in the prior amendment to distinguish the prior art was present in the claim prior to the amendment mailed to the Office on September 14, 1997. Accordingly, the amendment did not add a new limitation as suggested by the Examiner. Rather the amendment more specifically defined the second control means and did so with regard to how current flow is adjusted with respect to (a) charge level of rechargeable battery, (b) selected charging rate, and (c) selected power supply for the implantable medical device. Before and after the amendment, the second control means was coupled to the rechargeable power supply means (battery), the RF energy receiving

means, RF signal transmitting means, and implanted medical device (see prior amendment at page 2, lines 4-7 and lines 12-16) was added, thus no scope with regard to the subject matter discussed was surrendered by the amendment. Accordingly, there is no improper recapture as suggested by the Examiner.

Further, this rejection by the Examiner is obviated by the addition of the mode selection means, found to be distinguishing over the art by the Examiner in claim 23, to claim 29.

Accordingly, claim 29 is patentably distinguished over the prior art of record herein.

The Examiner's objection to claim 30 based on the misspelling of "into" is overcome by the correct spelling on --into-- in claim 30 above.

The Examiner's rejection of claim 28 under 35 U.S.C. § 112 for being indefinite, as this rejection may be attempted to be applied to amended claim 28, is respectfully traversed.

In support of this traverse, it is noted that claim 28 has been amended to delete the word "stop" and to change "rechargeable battery" to --rechargeable power supply--.

Also, claim 1 has been amended to include the word --and-- before the last element, "second control means ..." set forth in claim 1.

The Examiner's rejection of claim 28 Under 35 U.S.C. §103 for being unpatentable over the Mann, et al. U.S. Patent No. 4,082,097, as this rejection may be attempted to be applied to amended claim 28, is respectfully traversed.

In support of this traverse, it is pointed out that claim 28 calls for a coded signal being up-linked to the transmitting unit from the receiving unit. The Examiner contends that those of ordinary skill in the art would have considered such a feature to be a matter of obvious choice. However, the Examiner has not submitted any evidence to support this contention. See Ex parte Leavell, 212 USPQ 763 where Mr. Williamowsky speaking for the Patent and Trademark Board of Appeals stated:

"The legal conclusion of obviousness must be bottomed on a solid evidentiary base."

Further, only applicant teaches providing a coded signal such that it is not an obvious design choice. See Ex parte Dere, 118 USPQ 541. where Examiner in Chief Bailey stated:

“...the art contains no suggestion of having marked zones of perforation on opposing edges spaced according to the metric on English system respectively. The Examiner, as to this relationship, which is the very thing that yields the useful results already pointed out merely states it:

‘is not seen to provide a patentable distinction, being no more than a matter of choice.’

“Why he so holds he does not say and we do not see particularly since only the disclosure of the instant case makes a ‘choice’ available.”

Further, a rejection under 35 USC § 103 based on only one reference has been frowned upon and such a rejection can only be sustained if there is some suggestion, motivation incentive or direction in the reference to modify the reference to somehow come up with the applicant’s claimed invention. See Ex Parte Chicago Rawhide, 223 USPQ 351 and 226 USPQ 438 where the Board of Pat. App. & Int. stated:

“The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of the appellant’s specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the Banney device to render the here claimed device unpatentable.”

Still further, it is important to note that applicant has added to claim 28 a mode selection means, similar to the mode selection means set forth in claim 23 which the Examiner has noted is not suggested by any of the prior art.

Accordingly, applicant submits that claim 28 is clear of the art of record and otherwise in condition for allowance.

The Examiner’s rejection of claims 29-31 Under 35 U.S.C. §102(b) for being anticipated by the Schulman U.S. Patent No. 3,942,535, as this rejection may be

attempted to be applied to the amended claims 1-31 and the new claims 32-34, is respectfully traversed.

In support of this traverse, it is noted that claims 29-31 have been amended to include a mode selection means, similar to the mode selection means set forth in claim 23 which the Examiner found not to suggested by the prior art cited herein.

New claims 32-34 merely add the memory means (EEPROM 27) to the systems claimed in each one of claims 29-31.

Column 12 is being amended to correctly state reference numeral 27 (instead of 414) for the EEPROM shown in FIG. 6.

To complete the citation of background art, applicant is submitting an Information Disclosure Statement, a PTO Form 1449 and copies of 3 references, namely, the Schulman U.S. Patent No. 4,232,679, the Munshi et al. U.S. Patent No. 5,411,537 and the Wang et al. U.S. Patent No. 5,690,693 which applicant had located by double-checking the prior art patents in classes 607/33, 607/60, 607/61. The three new patents cited are believed to be cumulative to the references of record already cited and applied to the claims and therefore further comment on same does not appear to be necessary. These references merely fill out the background art.

The Information Disclosure Statement submitted herewith is accompanied by a check in the amount of \$180.00 to cover the submission fee for same.

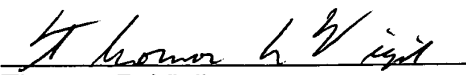
The allowability of claims 1-27 is noted.

For the foregoing reasons, applicant submits that claims 28-34 are now also in condition for allowance.

The original Letters Patent Document will be surrendered in the near future Under Rule 37 C.F.R. 1.178.

An earnest endeavor has been made to place this applicant in condition for allowance and an early and favorable action to that end is requested.

Respectfully submitted,

  
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